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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,547	04/18/2000	Takanobu Ihara	040373/0280	2187

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FOLEY AND LARDNER  
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WASHINGTON, DC 20007

EXAMINER

GESESSE, TILAHUN

ART UNIT PAPER NUMBER

2685

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/551,547

Applicant(s)

IHARA, TAKANOBU

Examiner

Tilahun B Gesesse

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 3 applicant fails to disclose in support of the claim subject matter "the plurality of mobile stations each have a transfer function for transferring a call directed to a line to another line". Neither the specification nor the drawing, has failed to disclose the detail how transfer function takes place from a line to another line. The specification in paragraph 3 on page 6, simply indicates that the transfer function is not shown. Therefore, applicant has failed to fully disclose in support of the subject matter of claim invention.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-2,4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr (us 6,223,055) in view of Bojeryd (us 5,771,465).

As to claims 1,5 Cyr discloses a private branch exchange system comprising: Cyr discloses a plurality of mobile stations with extension number that differ from the claim only in having each mobile stations different lines set for said plurality of extension numbers respectively. Bojeryd discloses allows one or more mobile wireless handsets and one or more wireline phones to function together as extension phones (col.2 lines 16-21), further more, Bojeryd discloses wireless subscriber A is assigned a set of extension phones, including HS 46 and wireline telephone 17, (col.5 lines 24-25). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to assign or set different lines to plurality of extension numbers, as evidenced by Bojeryd, Since mobile station has capability of moving and convenience to access which making a call and receiving a call, it is great improvement over the wired extension. Cyr discloses a base station (130) wirelessly connected to said plurality of

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mobile stations (120s)(fig.1). Cyr discloses an exchange station (140) for performing call control of said plurality of mobile stations through said base station (fig.1). As to claim 2, 6, Cyr fails disclose a unique extension number for each of said plurality of mobile stations. Bojeryd discloses that allows a subscriber to a single subscriber number assigned to both a conventional phone and mobile phone (col.2 lines 8-12). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to have a single number "unique extension" as evidenced by Bojeryd, in order to provide a private communication using private line. As to claim 4, Cyr in view of Bojeryd disclose all the claimed invention as explained in claim 1, further more, Cyr discloses each of said plurality of mobile stations has the same extension number as that of one or more predetermined other mobile station (col.3 lines 31-36). As to claim 7-11, Cyr does not disclose having a line key buttons for setting said plurality of lines. Bojeryd disclose a call setup request and using a keypad (fig.8 and col.7 lines 50-63). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to set up a call using keypad "key button" as evidenced by Bojeryd, in order to avoid unnecessary signaling and delay of making a call.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr in view of Bojeryd, as applied to claims 1-2 above, and further in view of Kim et al (us 5,375,162).

As to claim 3, Cyr in view of Bojeryd do not specifically disclose a transfer function for transferring a call direct to a line to another line. Kim et al , however, disclose the number of extension telephone 41 to 49 and a pager corresponding to each

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respective specific number is allocated to each of extension telephone, incoming call to extension telephone 49, in the case of not mapping a groups 71 to 79 on the extension subscriber telephone 49, the called extension subscriber puts the specific number and a delimiter in response to the incoming call into any extension subscriber telephone, PBX system 31 connects the communication path between the calling and called subscriber (col.3 line 34-col.4 line 25). The fact that called subscriber puts the specific number for the PBX system to transfer the incoming call to another extension telephone, is evidenced to equal to transfer function claim invention. It would have been obvious to a person of ordinary skill in the art at the time of invention was made to transfer a call from unattended extension line to another, as disclosed by Kim et al. using a pager "mobile station", in order to avoid calls unanswered or missed.

#### ***Allowable Subject Matter***

6. Claims 12-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Specification***

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 8149557 (6/1996 published) discloses cordless telephone system, includes many mobile stations where each is provided with its own set of extension numbers (title).

Arai (us 5,517,551) disclose main apparatus with plurality of mobile unit and plurality of extension telephones (fig.9).

**8. Any response to this action should be mailed to:**

*Commissioner of Patents and Trademarks*

*Washington, D.C. 20231*

**or faxed to:**

*(703) 872-9314, (for formal communications intended for entry)*

**Or:**

*(703) 746-6042 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")*

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor, (Receptionist).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873..

The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4750.

TBG

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Dec. 31, 2002

*Tilahun Gesesse*



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